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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. : 10/056,233

Filed: 01/28/2002*

Inventor: GUMMIN

Docket No.: 6100

Group Art Unit: 2834

Examiner: N/A

For: **SHAPE MEMORY ALLOY ACTUATOR**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

REQUEST TO CORRECT FILING DATE

Sir:

Applicant respectfully requests correction of the filing date accorded to the present patent application; that is, that this application be given the filing date of December 3, 2001. The reason for this request is the postal service interruption within the meaning of 35 U.S.C. 21(a) and 37 CFR 1.6(e).

The following facts are pertinent to this request.

On December 3, 2001, at approximately 4pm, I attempted to post the present application (a continuation of serial no. 09/566,446, now patent 6,326,707) at the US Postal Service Landscape Station in Berkeley, California. I placed the application in an Express Mail envelope, properly addressed to the Patent and Trademark Office. At the service counter, the clerk informed me that Express Mail to the PTO zip code was "embargoed", and could not be accepted. He suggested that I send the entire Express Mail package in a Priority Mail envelope, which was not under embargo, and that it would be received by the PTO. Knowing that the continuation application required a filing date of December 3 (the parent application was set to issue on December 4), I opted to send immediately the application via Priority Mail, including the entire Express Mail package therein. This Priority Mail posting was made on December 3, 2001, at

4:29pm. (copy of receipt attached.) The Express Mail package contained within the Priority Mail envelope thus should have been received by the PTO, with its date of December 3, 2001, the intended filing date of the present continuation application.

Returning to my office, I checked the PTO web site and found the following notice:

“In some cases, due to the recent emergency, certain post offices are refusing to accept the deposit of mail for delivery by Express Mail service. The USPTO is also designating this interruption in the Express Mail service of the USPS as a postal service interruption within the meaning of 35 U.S.C. 21(a) and 37 CFR 1.6(e). In addition, if a party attempts to deposit correspondence for delivery to the USPTO with the USPS by Express Mail under 37 CFR 1.10 ("Express Mail Post Office to Addressee") and the USPS refuses to accept such correspondence, the party is advised to take the following action: **mail the correspondence to the USPTO by registered or first class mail** with a statement by the person who originally attempted to deposit the correspondence with the USPS by Express Mail. The statement must indicate the date on which the person attempted to deposit the correspondence with the USPS and that the USPS refused to accept the correspondence. The statement must be signed in accordance with 37 CFR 10.18. The correspondence should be mailed as set out in 37 CFR 1.1(a) and include the special box designation: BOX FILING DATE.”

I then wrote a memo to my client (copy attached), summarizing what had transpired in the mailing process, to inform the client and to create a contemporaneous statement of the facts.

Accompanying this request are the following items to document the facts presented above: a copy of the memo to the client, stating the facts immediately after the occurrence, and a copy of the US Postal Service receipt for the Priority Mail posting of the present application.

Because counsel made a good faith effort to take advantage of the Express Mail filing provisions of the PTO, and was denied acceptance of the Express Mail posting, without prior warning, and thereafter immediately posted the application via first class mail (Priority Mail), counsel respectfully requests that the present application be accorded the filing date of the attempted Express Mail posting: December 3, 2001. This request is in compliance with the PTO advisory stated above.

All statements made herein of the party's own knowledge are true, all statements made herein on information and belief are believed to be true, and all

statements made herein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom.

Respectfully Submitted,



Howard Cohen
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Berkeley, CA 94707
510-524-7733
fax 510-558-7260

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as properly posted first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington D.C. 20231, on

3/27/2002

3/27/2002

date





Memorandum: Mark Gummin, Bill Donakowski

Re: SMA continuation patent application

Date: 12/4/01

Well, after receiving on 12/3, 1:15 PM, the PTO notification of issuance of the SMA parent patent on 12/4, and getting the go-ahead from Mark, I hastily prepared a continuation application using the original disclosure and drawings and writing 12 new claims. I printed and filled in the necessary PTO forms, put the package together, and went to the Post office around 4pm. Of course, there was a long line of Christmas mailers. When I finally got to the window at 4:30, the clerk took a second look at the Express Mail envelope and said, Oh, sorry, there's an embargo on all Express mail to that zip code. Imagine my surprise, but I guess it's because of the Anthrax scare in DC. The clerk suggested that I could put the envelope into a Priority Mail envelope and send it that way, since there is no embargo on Priority Mail. (What's the difference in terms of anthrax contamination, you may ask? Beats me...)

I made a quick decision and sent the Express Mail package inside a Priority Mail envelope. Eventually it will get opened at the PTO, and we will get a serial number and filing date. We may have to petition the Commissioner to be accorded the filing date of 12/3, based on our good faith best effort to comply with the Express Mail dating provisions of the regulations. We will see.

I'm sorry that I can't report that it all went smoothly, but I certainly did my utmost to get the filing date of 12/3.

All the best,
Howard

PS – I found the following guideline on the PTO web page just now, and it seems to support the mailing I did. I will send the requisite statement when we receive a serial number and filing date.

“In some cases, due to the recent emergency, certain post offices are refusing to accept the deposit of mail for delivery by Express Mail service. The

USPTO is also designating this interruption in the Express Mail service of the USPS as a postal service interruption within the meaning of 35 U.S.C.

21(a) and 37 CFR 1.6(e). In addition, if a party attempts to deposit correspondence for delivery to the USPTO with the USPS by Express Mail under 37 CFR 1.10 ("Express Mail Post Office to Addressee") and the USPS refuses to accept such correspondence, the party is advised to take the following

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LANDSCAPE STATION
BERKELEY, California
947072306
12/03/2001 (800)275-8777 04:29:41 PM

Product Description	Sale Qty	Unit Price	Final Price
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WASHINGTON DC 20231 Priority Mail			\$3.50
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Issue PVI:	\$3.50
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Total:	\$3.50
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Paid by:	
Cash	\$20.00
Change Due:	-\$16.50

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Clerk: 01

Refunds only per DMM P014
Thank you for your business
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